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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,781	08/17/2001	Sang-Ho Park	678-721 (P9889)	3651

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EXAMINER

GIBSON, ERIC M

ART UNIT	PAPER NUMBER
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3661

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/931,781	Applicant(s) PARK ET AL.	
	Examiner Eric M Gibson	Art Unit 3661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,8-10,12-15,17-22,24-29 and 31-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 2, 8-10, 12-15, 17-22, 24-29,31,43-52 and 59-67 is/are allowed.
- 6) ☒ Claim(s) 32-42,53-58 and 68-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 68-73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 68-73 recite the limitation "the mobile terminal" in the preamble.

There is insufficient antecedent basis for this limitation in the claims. The claims recite dependency from "the mobile terminal of claim ...", however the claims from which these claims depend (claims 18 and 25) are method claims, not apparatus claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 32-42, 53-58, and 74-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barber (US006029072A) in view of Pu et al. (US006292743B1).

a. As per claim 32, Barber teaches a portable telephone with terminal mode facility, including use in a navigation system wherein the mobile terminal acts in a conventional bi-communications mode in a first mode and downloads navigation data when set in a second, "terminal", mode (column 3, lines 40-47). Barber teaches that the mobile terminal interfaces with the navigation system (column 3, lines 63-66) but does not disclose the details of the functionality of the navigation system, such as requesting route guidance data that satisfies a predetermined condition selected by a user. In the art of navigation systems, it is well known that their function is to guide a user to a destination based on inputted search and destination criteria. This is the typical state of the art navigation system capability. Pu is referenced as evidence of one such navigation system wherein a user requests route guidance data that satisfies a selected predetermined condition (column 8, lines 26-30). It would have been obvious to one of ordinary skill in the art, at the time of invention, to use the navigation system taught in Barber according to the typical use of such a system in requesting route guidance data that satisfies a predetermined condition selected by a user, as evidenced by Pu.

b. As per claim 33, Barber teaches the system is mounted in a vehicle, which is a moving object.

c. As per claim 34, Pu teaches that destination parameters are typical of the art of navigation systems (column 7, line 63-64).

d. As per claim 35, Pu teaches that the information center (server 114) provides route guidance data to the destination.

e. As per claim 36, Barber teaches that the mobile terminal includes a display (column 3, line 39) for displaying the state of call processing (column 3, lines 50-53).

f. As per claim 37, Barber teaches that the mobile terminal includes an input portion (column 3, line 39).

g. As per claim 38, Barber teaches that the system includes a microphone (column 4, line 11).

h. As per claim 39, Barber teaches that the input portion includes a keypad (270, column 3, line 39).

i. As per claim 40, Barber teaches including a key assigned to activating the terminal mode on the keypad (column 3, lines 45-47).

j. As per claim 41, Barber teaches a mobile terminal including an input portion (270, column 3, line 39) for acting as a user interface for a navigation mode selected by the user and a display for displaying route guidance data about the vehicle (column 3, line 39). Barber teaches that the mobile terminal interfaces with the navigation system (column 3, lines 63-66) but does not disclose the details of the functionality of the navigation system, such as requesting route guidance data selected by a user. In the art of navigation systems, it is well known that their function is to guide

Art Unit: 3661

a user to a destination based on inputted search and destination criteria. This is the typical state of the art navigation system capability. Pu is referenced as evidence of one such navigation system wherein a user requests route guidance data that satisfies a selected predetermined condition (column 8, lines 26-30). It would have been obvious to one of ordinary skill in the art, at the time of invention, to use the navigation system taught in Barber according to the typical use of such a system in requesting route guidance data selected by a user, as evidenced by Pu.

k. As per claim 42, Barber teaches sensing a voice call and transitioning to the voice call mode (column 8, lines 8-11).

l. As per claims 53-56 and 74-76, it is well known and understood in the art that typical navigation systems provide their location information, including position, speed and bearing derived from GPS sensors or other sources, as shown by Pu (column 6, lines 59-60).

m. As per claims 57 and 58, Barber teaches that the second mode is activated upon the selection from a menu or a dedicated key (column 3, lines 44-48).

Allowable Subject Matter

3. Claims 1-31, 43-52, 59-67 are allowed.

a. As per independent claims 1, 12, 18, and 25, the amendment to the claims filed on 1/7/2004 overcomes the previous rejection. Specifically, the prior art does not teach or reasonably suggest in combination the present invention including the determining a notification message regarding the at least one node point from the

present position and guidance codes in the route guidance data, generating the notification message about the at least one node point referring to a database contained in the navigation terminal and announcing the notification message, in the system and method as claimed.

b. Claims 2-11, 13-17, 19-24, 26-31, 43-52, and 59-67 serve to further define the invention of claims 1, 12, 18, and 25 over the prior art.

4. Claims 68-73 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

a. Claims 68-73 would serve to further define the invention of claims 18 and 25 over the prior art.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Oshizawa (US005987381A) teaches an automobile navigation system using remote download of data. Ben-Yehezkel et al. (US006049711A) teaches a method and apparatus for providing location-based information services.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

Art Unit: 3661

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric M Gibson whose telephone number is (703) 306-4545. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on (703) 308-3873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EMG



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